

REMARKS

I. Introduction

With the addition of new claims 29 to 39, claims 18 to 39 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Allowed Claim 28

Applicants note with appreciation the indication that claim 28 is allowed.

III. Correction of Typographic Errors in Claims 18 and 27

The Examiner will note that claims 18 and 27 have been amended herein without prejudice to correct certain typographic errors. In particular, the article "an" before "martensite" has been changed to --a-- in each of claims 18 and 27.

IV. Rejection of Claims 18, 25 and 26 Under 35 U.S.C. § 102(b)

Claims 18, 25 and 26 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,788,417 ("Graflind"). Applicants respectfully submit that Graflind does not anticipate the present claims for at least the following reasons.

Claim 18 relates to an arrangement for controlling a shape of a stent body. Claim 18 recites that the arrangement includes an electrical circuit for establishing an electrical current flow through the stent for heating the stent to cause the stent to shift from a martensite phase to an austenite phase to change the shape of the stent body. Claim 18, as amended herein without prejudice, further recites that the electrical circuit is adapted to monitor a phase change of the stent from the martensite phase to the austenite phase and that the electrical circuit is adapted to control the flow of electrical current through the stent as a function of the phase change of the stent from the martensite phase to the austenite phase. Support for these amendments may be found, for example, on page 20, line 9 to page 21, line 25 of the Specification.

Graflind purports to relate to an electrical heating pad. Graflind makes no mention whatsoever of an electrical circuit that is adapted to monitor a phase change of a stent -- or any other object -- from a martensite phase to an austenite

phase. Consequently, Graflind also makes no mention whatsoever of an electrical circuit that is adapted to control a flow of electrical current through a stent -- or any other object -- as a function of a phase change from a martensite phase to an austenite phase. Any assertions to the contrary in the Final Office Action are based on nothing more than pure speculation or conjecture, which cannot support an anticipation rejection.

The assertions contained in the Final Office Action that the circuit allegedly described by Graflind "could have been used to heat a stent and would operate as claimed" is unsupported. Even if an electrical circuit described by Graflind "could have been used to heat a stent" -- which is not conceded -- it is respectfully submitted that such an electrical circuit would still not disclose, or even suggest, all of the features recited in claim 18. Graflind merely mentions that control units C01 to C08 are connected to a monitor unit 23 adapted to sequentially sense the resistance of the resistor strip in each foil element in order to monitor the temperature of each foil unit, the temperature being dependent on the resistance. However, Graflind makes no mention of monitoring a phase change from a martensite phase to an austenite phase or of controlling flow of an electrical current as a function of a phase change from a martensite phase to an austenite phase.

Since there is no express disclosure by Graflind of an electric circuit adapted to monitor a phase change from a martensite phase to an austenite phase or of an electrical circuit adapted to control a flow of electrical current as a function of a phase change from a martensite phase to an austenite phase, the present rejection is apparently based on the personal knowledge of the Examiner. Thus, Applicants respectfully request that the Examiner provide an affidavit under 37 C.F.R. § 1.104(d)(2) and/or that the Examiner provide published information concerning the unsupported and conclusory assertions that an electrical circuit described by Graflind "would operate as claimed" or otherwise discloses or suggests all of the features of claim 18.

It is "well settled that the burden of establishing a *prima facie* case of anticipation resides with the [United States] Patent and Trademark Office." Ex parte Skinner, 2 U.S.P.Q.2d 1788, 1788 to 1789 (Bd. Pat. App. & Inter. 1986). To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical

invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Graflind does not disclose, or even suggest, an electrical circuit as recited in claim 18. It is therefore respectfully submitted that Graflind does not anticipate claim 18.

As for claims 25 and 26, which depend from claim 18 and therefore include all of the features of claim 18, it is respectfully submitted that Graflind does not anticipate these dependent claim for at least the same reasons more fully set forth above in support of the patentability of claim 18.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

V. Rejection of Claims 18 to 20, 25 and 26 Under 35 U.S.C. § 102(b)

Claims 18 to 20, 25 and 26 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,695,709 (“Sachs et al.”). Applicants respectfully submit that Sachs et al. do not anticipate the present claims for at least the following reasons.

Sachs et al. purport to relate to a method and apparatus for heating and controlling the temperature of ultra small volumes. Although Sachs et al. mention a closed loop control of the temperature of a heater-sensor 21 by a servo amplifier 43, Sachs et al. make no mention whatsoever of an electrical circuit that is adapted to monitor a phase change of a stent -- or any other object -- from a martensite phase to an austenite phase or to control a flow of electrical current through a stent -- or any other object -- as a function of a phase change from a martensite phase to an austenite phase. Any assertions to the contrary contained in the Final Office Action are apparently based on nothing more than pure speculation or conjecture, which cannot sustain an anticipation rejection. Since there is no express disclosure by Sachs et al. of an electrical circuit adapted to monitor a phase change from a martensite phase to an austenite phase or of an electrical circuit adapted to control a flow of electrical current as a function of a phase change from a martensite phase to an austenite phase, the present rejection is apparently based on the personal knowledge of the Examiner. Thus, Applicants respectfully request that

the Examiner provide an affidavit under 37 C.F.R. § 1.104(d)(2) and/or that the Examiner provide published information concerning the unsupported and conclusory assertions that an electrical circuit described by Sachs et al. "would operate as claimed" or otherwise discloses or suggests all of the features of claim 18. In view of the foregoing, it is respectfully submitted that Sachs et al. do not anticipate claim 18.

As for claims 19, 20, 25 and 26, which depend from claim 18 and therefore include all of the limitations of claim 18, it is respectfully submitted that Sachs et al. do not anticipate these dependent claims for at least the same reasons more fully set forth above in support of the patentability of claim 18.

VI. Rejection of Claims 18 to 26 Under 35 U.S.C. § 102(b)

Claims 18 to 26 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,359,626 ("Potter"). Applicants respectfully submit that Potter does not anticipate the present claims for at least the following reasons.

Potter purports to relate to an electric blanket heating control with capacitance sensing. Potter makes no mention whatsoever of an electrical circuit that is adapted to monitor a phase change of a stent -- or any other object -- from a martensite phase to an austenite phase or to control a flow of electrical current through a stent -- or any other object -- as a function of a phase change from a martensite phase to an austenite phase. Any assertions to the contrary contained in the Final Office Action are apparently based on nothing more than pure speculation or conjecture, which cannot sustain an anticipation rejection. Since there is no express disclosure by Potter of an electrical circuit adapted to monitor a phase change from a martensite phase to an austenite phase or of an electrical circuit adapted to control a flow of electrical current as a function of a phase change from a martensite phase to an austenite phase, the present rejection is apparently based on the personal knowledge of the Examiner. Thus, Applicants respectfully request that the Examiner provide an affidavit under 37 C.F.R. § 1.104(d)(2) and/or that the Examiner provide published information concerning the unsupported and conclusory assertions that an electrical circuit described by Potter "would operate as claimed" or otherwise discloses or suggests all of the features of claim 18. In view of the foregoing, it is respectfully submitted that Sachs et al. do not anticipate claim 18.

As for claims 19, 20, 25 and 26, which depend from claim 18 and therefore include all of the limitations of claim 18, it is respectfully submitted that

Sachs et al. do not anticipate these dependent claims for at least the same reasons more fully set forth above in support of the patentability of claim 18.

VII. Objection to Claim 27

As regards the objection to claim 27, the Examiner's attention is respectfully directed to the first paragraph of M.P.E.P. § 706.03(k), which plainly sets forth that Applicants have the right to restate, *i.e.*, by plural claiming, the claimed subject matter in a reasonable number of ways and that a mere difference in scope between claims is sufficient. Withdrawal of this objection is therefore respectfully requested.

VIII. New Claims 29 to 39

New claims 29 to 39 have been added herein. It is respectfully submitted that new claims 29 to 39 add no new matter and are fully supported by the present application, including the Specification.

Since claims 29 to 36 ultimately depend from claim 28, which was indicated to be allowed, it is respectfully submitted that claims 29 to 36 are in condition for immediate allowance.

Since claims 37 to 39 depend from claim 18, it is respectfully submitted that claims 37 to 39 are patentable over the references relied upon for at least the same reasons more fully set forth above in support of the patentability of claim 18.

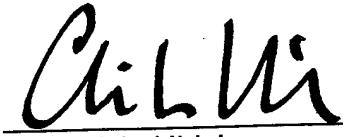
IX. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

Date: March 1, 2005 By:


Clifford A. Ulrich
Reg. No. 42,194

One Broadway
New York, New York 10004
(212) 425-5288
CUSTOMER NO. 26646